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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/806,309	03/22/2004	Michael J. Czaplicki	1001-112C1	1828

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EXAMINER

SELLERS, ROBERT E

ART UNIT PAPER NUMBER

1712

DATE MAILED: 08/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/806,309

Applicant(s)

CZAPLICKI ET AL.

Examiner

Robert Sellers

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 20-43 is/are pending in the application.
- 4a) Of the above claim(s) 25,26,33 and 36-43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20-22, 24, 27-29, 34 and 35 is/are rejected.
- 7) ☒ Claim(s) 23,31 and 32 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9 August 2004.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

The application would be more accurately designated as a divisional on page 1 of the specification since patented parent application no. 10/217,991 defines the synthetic material wherein the instantly claimed method of providing reinforcement was withdrawn as a non-elected invention in the non-Final rejection mailed October 28, 2003.

1. The election with traverse of Group I, bisphenol A epoxy resin as both the polymeric base material and the correspondence component in the powder and the presence of a blowing agent in the base material of claim 32 in the reply filed on July 13, 2006 is acknowledged. The traversal is on the grounds that the inventions are not independent since there is a relationship between them.
2. This is not found persuasive because according to MPEP § 806, Determination of Distinctness or Independence of Claimed Inventions, restriction is proper not only where inventions are independent, but also "(B) [w]here inventions are related as disclosed but are distinct as claimed . . . ." Elected claims 20-24, 27-32 and 34-36 and non-elected claims 25, 26, 33 and 37-43 fall within the related inventions designated in MPEP § 806.05(c), Criteria of Distinctness Between Combination and Subcombination under section II. Subcombination Not Essential to Combination, A.  $AB_{br}/B_{sp}$  Restriction Proper. The elected claims within  $AB_{br}$  do not require neither the applying of the release paper in claims 25, 26 and 43 of Group II, the inclusion of the curing agent in the base material in claims 33, 37, 38 and 40-42 of Group III, nor the removal of the release paper in claim 39 of Group IV.

Art Unit: 1712

The B<sub>sp</sub> of Groups II, III and IV have separate utilities such as the preparation of a tape with a polymer backing. Furthermore, "[t]he omission of the details of the subcombination B<sub>sp</sub> in the combination claim AB<sub>br</sub> is evidence that the combination does not rely upon the specific limitations of the subcombination for its patentability."

The requirement is still deemed proper and is therefore made FINAL.

Claims 25, 26, 33 and 37-43 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction requirement in the reply filed on July 13, 2006. Claim 36 is withdrawn as being directed to a non-elected species of acetate, acrylate or elastomer as the correspondence component.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 1712

Claims 20-22, 24, 27-29, 34 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Patel Patent No. 6,136,732 (equivalent to PCT Publication No. WO 00/10802) or Japanese Patent No. 56-118816.

3. Patel (col. 1, lines 57-62) discloses an adhesive for use in the automotive industry (col. 1, lines 18-20 and col. 2, lines 8-11) prepared by (col. 3, lines 36-41) dispensing a thermosetting powder adhesive such as a polyester (col. 2, lines 54-57) upon a thermoplastic non-woven web adhesive including a polyester (col. 2, lines 61-67) applied to an incompatible material (col. 5, lines 4-6).

4. The Japanese patent reports ceiling material for automobiles (CAPLUS abstract) obtained by coating a thermoplastic base material such as high density polyethylene with a thermoplastic powder adhesive such as polyethylene (Derwent abstract) laminated onto a substrate.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 1712

Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Patel and Japanese Patent No. 56-118816 (Japanese '816)

5. The references are described hereinabove. The claimed greater molecular weight of the correspondence components in the powder over that of the based material is not recited. It would have been obvious to employ the powdered polyester of Patel or the powdered polyethylene of Japanese '816 having a greater molecular weight than that of the polyester or polyethylene base material, respectively, in order to impart more structural integrity and strength to the adhesive layer between the base material and the substrate to be applied thereto.

Claims 23, 31 and 32 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. None of the cited prior art recites the epoxy resin of claim 23 as the correspondence component of the powder which according to page 7, line 27 to page 8, line 6 of the specification is defined as being either substantially identical, a substantially identical monomer or oligomer, or insubstantially different but with at least a similar polymeric structure but a higher molecular weight, with a component in the base material. The cited references do not recite the expandable material as the base material of claim 31, nor the inclusion of a blowing agent in the base material of claim 32.

Art Unit: 1712

7. Holdsworth et al. Patent No. 4,852,754; Simmons et al. Patent No. 5,605,717 and European Patent Nos. 360,214 and 1,126,001 do not recite the claimed step of dispensing the correspondence components upon the base material in the form of a powder. There is no motivation to apply the heat-activated polymer adhesives of the references as powders.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Sellers whose telephone number is (571) 272-1093. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).



Robert Sellers  
Primary Examiner  
Art Unit 1712